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REMARKS

1) The Examiner has rejected claims 1, 6-9 and 13-15 under 35 U.S.C. 103 over Takagi et al. (U.S. Publ. 2004/0226818). The Examiner asserts that it would be obvious for one skilled in the art to formulate the presently claimed invention upon a reading of Takagi. Applicants respectfully urge that this is not the case.

The present invention claims a silver alloy for use in a reflection film, said silver alloy consisting of silver, gallium, and either dysprosium or thulium. The wording of claim 1 limits the present invention to alloys containing combinations of only these materials, no more and no less.

Takagi relates to a sputtering target made of a Ag-Bi base alloy, having bismuth in solid solution with silver. Indeed the alloy of Takagi may further include other elements which are in common with the present invention, such as gallium or dysprosium or thulium. However, nothing in Takagi teaches or suggests an embodiment which *consists of* only silver, gallium, and either dysprosium or thulium as presently claimed. That is, Takagi *requires* the presence of bismuth in all of their alloy embodiments. This directly teaches away from the presently claimed invention, which requires the *absence* of bismuth due to the presence of the phrase "consisting of".

The Examiner points to MPEP §2111.03, which relates to the use of the phrase "consisting of" in the claims. MPEP §2111.03 specifically states that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). Thus, the use of the phrase "consisting of" in the present claims excludes the presence of further ingredients, such as bismuth, in the presently claimed alloys, and thus renders the present invention patentably distinct and non-obvious in view of Takagi. The Examiner

attempts to negate the present use of the term "consisting of", by pointing to one case law exception provided in MPEP §2111.03, and relating to *Norian Corp. v. Stryker Corp.*, 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004). That case held that a bone repair kit "consisting of" claimed chemicals was infringed by a bone repair kit including a spatula in addition to the claimed chemicals *because the presence of the spatula was unrelated to the claimed invention*. Applicants respectfully urge that the exception of *Norian* clearly does not apply in the instant case, since the presence of bismuth in Takagi's alloy is a key component of their claimed invention.

The Examiner further rejects the dependent claims, offering specific arguments against claims 7-8, stating that the additive percentages of these claims broadly overlap the percentages of supporting elements cited by Takagi. However, whether or not an individual feature of a dependent claim may be otherwise known in the art, it is urged that the overall combination of an independent claim with such a feature of the dependent claim should not be considered prima facie obvious. It is urged that all claims depending from claim 1 relate to *narrower* embodiments of the invention disclosed in claim 1. Therefore, where the subject matter of claim 1 is sufficiently inventive, for the reasons argued above, all claims depending from claim 1 should be considered inventive as well.

It is strongly urged that one skilled in the art would not have been inspired to formulate the presently claimed alloy upon reading the disclosure of Takagi. It is therefore respectfully submitted that the presently claimed invention is not prima facie obvious in view of Takagi, and that the 35 U.S.C. 103 rejection should be withdrawn.

2) The Examiner has rejected claims 1, 6-9 and 13-15 under 35 U.S.C. 103 over Scuntjens (U.S. 6,294,738). Applicants respectfully submit that the presently claimed invention is not obvious in view of this cited reference.

Scuntjens relates to a method for fabricating silver or silver alloy tube stock. The Examiner cites column 6, lines 15-18 of Suentjens, asserting that the listed materials for possible silver alloys broadly overlaps the presently claimed alloys. Applicants

respectfully disagree. The paragraph pointed out by the Examiner lists possible materials which may be combined with silver to form a silver alloy. The paragraph specifically lists gold, platinum, palladium, aluminum, magnesium, copper, lithium, sodium, potassium, calcium, beryllium, strontium, barium, yttrium, scandium, lanthanum, cerium, praseodymium, neodymium, promethium, samarium, europium, gadolinium, terbium, dysprosium, holmium, erbium, thulium, ytterbium, lutetium, titanium, zirconium, hafnium, vanadium, niobium, tantalum, silicon, germanium, antimony, tin, lead, gallium, indium, thallium, zinc, bismuth, or mercury. Thus, Seuntjens broadly discloses the formation of a silver alloy which may contain gallium or thallium or dysprosium. However, this reference does not provide a single embodiment relating to an alloy consisting of silver and gallium, and either dysprosium or thallium. Thus, the presently claimed silver alloys are clearly not obviated by the Seuntjens reference.

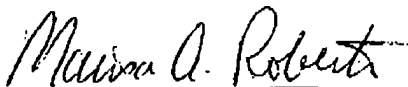
Furthermore, it is urged that one skilled in the art would not have been inspired to look to the teachings of Seuntjens, in an effort to devise the presently claimed invention. The cited reference relates to alloys for tube stock, wire, tapes, cables, and the like. Nothing in this reference teaches or suggests any use reflection films at all. It is submitted that materials are optimized for their different uses, and that one skilled in the art would not have been motivated to seek out materials optimized for tube stock and the like, in an effort to devise an alloy suited for a reflection film.

The Examiner goes on to reject claims 9, 14, and 15 for stating that the term "sputtering target" does not impart any specific physical configuration, and that the materials of Seuntjens are therefore assumed to be useful as sputtering targets. Applicants strongly disagree. First, sputtering targets are well known in the ceramic and metal manufacturing fields. In fact, a search of the U.S. Patent and Trademark Office website yields over 1000 granted U.S. patents having the term "sputtering target" in the claims. Secondly, the Examiner has provided no scientific or factual showing to support his position that the materials of Seuntjens can be considered "useful" as a sputtering target.

Regarding claim 7-8, the Examiner agrees that Seuntjens fails to mention the concentration percentages of the alloy elements as provided in the present claims 7 and 8. The Examiner goes on to assert that it would be obvious for one skilled in the art to determine optimal workable ranges for certain variables. However, as stated above, Applicants respectfully urge that all claims depending from claim 1 relate to *narrower* embodiments of the invention disclosed in claim 1. Since it is urged that the subject matter of the present claim 1 is sufficiently inventive for the reasons argued above, it is further urged that all claims depending from claim 1 are inventive as well. For all of the above reasons, it is urged that the presently claimed invention is not *prima facie* obvious in view of Seuntjens, and that the 35 U.S.C. 103 rejection should be withdrawn.

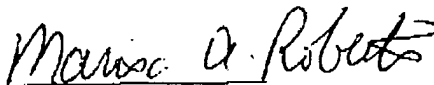
The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office (FAX No. (571) 273-8300) on November 29, 2007.



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